

REMARKS

Please reconsider this application in view of the above amendments and the following remarks.

- Claims 1, 3-5, 7, 11-13, 17-19 and 21-33 are pending.
- Claims 1, 3-5, 7, 11-13, 17-19 and 21-33 are rejected.
- Claims 2, 6, 8-10, 14-16 and 20 are canceled.

Applicant points out that it has not received confirmation that the Examiner has considered the Information Disclosure Statement filed on December 20, 2001. Applicant would appreciate the Examiner providing this confirmation with the next office action.

Applicant has amended the specification substantially as requested by the Examiner.

Applicant has amended claim 19 to incorporate the limitations of claim 20 and has canceled claim 20.

Applicant has corrected the drawings as requested by the Examiner. Formal drawings are also submitted.

The Examiner has rejected claims 1, 3-5, 7, 11-13, 17-18, 21-22, and 25-33 under 35 USC §102(b) as being anticipated by Brisken et al., U.S. Patent No. 5,735,811 -- D1.

The Examiner takes the position that a portion of figure 10 of D1 inherently discloses a gap with a low density material contained in the gap. With respect to an anticipatory rejection based in part on inherency, the law is clear. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities.' MPEP § 2112 (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). "In relying upon the theory of inherency, the examiner must

provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art." MPEP § 2112 (quoting *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

This gap does not inherently contain a low density material because it does not necessarily contain air. For instance, there is no disclosure that this region is fluid-tight. If not fluid-tight and packaged in saline or flushed and filled with saline before deployment, the gap would contain water, which is not a low density material. The Examiner even recognizes that the environment surrounding the device of D1 would influence the contents of this gap. While a vacuum is unlikely unless disclosed, catheters are frequently packaged in saline solution and are frequently rinsed with saline solution before use. Therefore, this gap need not absolutely contain air. Furthermore, if the gap were fluid tight, D1 would so disclose; since it does not disclose a fluid-tight gap at the very least one of ordinary skill in the art would expect the gap to fill with blood when the catheter was deployed.

But claims 1 and 17 recite a function for the gap during use of the device. Therefore, applicant's claims disclose that the gap remain filled with a low density material after deployment.

Claims 3-5, 7, 11, and 18, 21-22 depend from Claims 1 and 17, respectively and contain all the limitations of these claims. This makes the dependent claims patentable over D1 for at least the same reasons that were discussed for the independent claims. Please remove the rejection of these claims, as well.

Furthermore, because *prima facie* obviousness or anticipation has not been made out, Applicant is under no duty to address the remainder of the Examiner's discussion in this section of the office action including the discussion of the dependent claims. But should such a duty arise in the future, Applicant reserves the right to address that discussion then. Applicant specifically does not acquiesce to the facts, assumptions, or reasoning contained in this section.

As for claim 12, the claim recites a plurality of transducers "wherein the distal end of a transducer is positioned at a distance from the proximal end of an adjacent transducer to allow the catheter to bend in the area between a pair of adjacent transducers."

D1 is silent with respect to this limitation. Therefore, D1 does not anticipate claim 12.

Claims 13, 32, and 33 depend from Claims 12, respectively and contain all the limitations of these claims. This makes the dependent claims patentable over D1 for at least the same reasons that were discussed for the independent claims. Please remove the rejection of these claims, as well.

Furthermore, because *prima facie* obviousness or anticipation has not been made out, Applicant is under no duty to address the remainder of the Examiner's discussion in this section of the office action including the discussion of the dependent claims. But should such a duty arise in the future, Applicant reserves the right to address that discussion then. Applicant specifically does not acquiesce to the facts, assumptions, or reasoning contained in this section.

Claim 25 is similar to Claim 12 but recites a second transducer rather than a plurality. Otherwise, the analysis is the same for Claim 25 and its dependent Claims 26-27, as was discussed for Claim 12 and its dependent claims,

Please remove this rejection of Claim 25-27.

Furthermore, because *prima facie* obviousness or anticipation has not been made out, Applicant is under no duty to address the remainder of the Examiner's discussion in this section of the office action including the discussion of the dependent claims. But should such a duty arise in the future, Applicant reserves the right to address that discussion then. Applicant specifically does not acquiesce to the facts, assumptions, or reasoning contained in this section.

Claim 28 recites pieces "sealed against the lumen to create an enclosed space." D1 does not teach such sealing. Therefore, D1 does not anticipate Claims 28.

Claim 29-31 depend from Claim 28 and contain all the limitations of these claims. This makes the dependent claims patentable over D1 for at least the same reasons that were discussed for the independent claim. Please remove the rejection of these claims, as well.

Furthermore, because prima facie obviousness or anticipation has not been made out, Applicant is under no duty to address the remainder of the Examiner's discussion in this section of the office action including the discussion of the dependent claims. But should such a duty arise in the future, Applicant reserves the right to address that discussion then. Applicant specifically does not acquiesce to the facts, assumptions, or reasoning contained in this section.

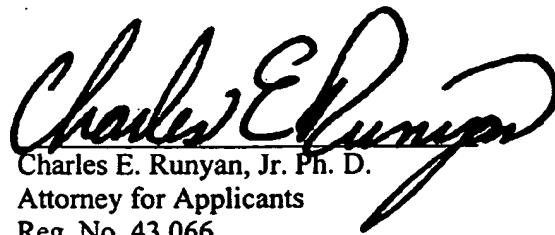
The Examiner has rejected claims 19-20, and 23-24 under 35 USC §103(a) as being unpatentable over D1 in view of Bock, U.S. Patent No. 5,618,275 -- D2.

As amended claim 19 recites interposing a gap between a catheter and a transducer in order to amplify ultrasonic energy, wherein the gap contains a low density material. As discussed above, D1 does disclose a gap containing a low density material. D2 does not cure this defect. Therefore, prima facie obviousness has not been made out for claims 19, 20, 23, or 24. Please remove this rejection of the claims.

Furthermore, because prima facie obviousness or anticipation has not been made out, Applicant is under no duty to address the remainder of the Examiner's discussion in this section of the office action including the discussion of the dependent claims. But should such a duty arise in the future, Applicant reserves the right to address that discussion then. Applicant specifically does not acquiesce to the facts, assumptions, or reasoning contained in this section.

Since all claims are in a condition for allowance, please issue a Notice of Allowability so stating. If I can be of any help, please contact me.

Respectfully submitted,


Charles E. Runyan, Jr. Ph. D.
Attorney for Applicants
Reg. No. 43,066

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Squire, Sanders & Dempsey L.L.P.
One Maritime Plaza
Suite 300
San Francisco, CA 94111
Telephone 415.954.0235
Facsimile 415.393.9887
crunyan@ssd.com